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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/177,502 10/23/98 SLATER

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EXAMINER

PEFFLEY, M

ART UNIT

PAPER NUMBER

3739

13

DATE MAILED: 05/29/01

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 13

Application Number: 09/177,502
Filing Date: October 23, 1998
Appellant(s): SLATER, CHARLES R.

Leslie I. Bookoff
For Appellant

MAILED
MAY 25 2001
GROUP 3700

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed April 23, 2001.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

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(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 24-29 and 40-56 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

5,352,222

Rydell

10-1994

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(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 24, 25, 28, 29, 40, 41, 44 and 46-56 are rejected under 35 U.S.C. 102(g).

This rejection is set forth in prior Office Action, Paper No. 8.

Claims 26, 27, 42, 43 and 45 are rejected under 35 U.S.C. 102(g)/103(a). This rejection is set forth in prior Office Action, Paper No. 8.

Finally, claims 24-29 and 40-56 are additionally rejected on the grounds of collateral estoppel. Applicant's failure to properly move under 37 CFR 1.633(c)(1) to add a second count to the interference proceedings has created the ground of estoppel as set forth in 37 CFR 1.658(c).

(11) *Response to Argument*

The examiner's position with respect to the rejections remains as stated in the Final Office Action of April 24, 2000. Rather than reiterate those arguments, the examiner will address specific issues raised in Appellant's Brief, and rely on the rejections made in the earlier Office actions.

Interference Decision

Interference No. 103,765 was decided prior to final hearing, and the decision was entered based on the Junior Party's request for adverse judgment. As such, the only issue finally decided was the priority of the invention. There was no final judgment on the issue of patentability.

The "Blade" Claims

The examiner maintains that there is a fundamental difference between the blade claims originally presented in the original Rydell application (Application Serial No. 08/213,671), and the endoscopic scissors blade claims which have issued in the Reissue Patent RE 36,795. In particular, the claims originally presented in the '671 application (which claims were canceled after a restriction requirement) were drawn to a "blade", per se, and could have been directed to a scalpel blade, a scissors blade, or any other reasonable interpretation of a blade. As such, the examiner maintains that the restriction made in the '671 application was merited because the subcombination (i.e. the blade) had separate utility by itself or in other combinations. The preamble of claim 15 in the '795 Reissue is directed to "An endoscopic scissors blade". The examiner maintains that there would be no merit in making a restriction of these claims (had they been part of the original '671 application) because the preamble precludes their use in other combinations or devices.

Turning now to the examiner's decision to enter the endoscopic scissors blade in the Reissue application, the examiner maintains that decision of APJ Pate in Paper No. 31 of the Interference proceedings was an interlocutory decision. APJ Pate agreed with Junior Party's assertion that Rydell's attempt to enter the "blade" claims was impermissible based on recapture of forfeited subject matter. Again, there was no final decision on the issue of patentability because of the Junior Party request for adverse judgment. As such, the examiner disagrees with APJ Pate's decision on recapture, and

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has permitted the endoscopic scissors blade claims to be entered into the Reissue application.

Rejection base on Estoppel

The examiner's rejection on estoppel is based on Rule 658(c) which requires parties to take all necessary actions during the course of interference proceedings. Appellant is arguing that APJ Pate had determined that the "blade" claims were not patentable to Rydell, and that there was no reason for the Junior Party (i.e. appellant) to raise the same issue.

The examiner again maintains that there was no final ruling with respect to patentability. Rather, APJ Pate's decision was an interlocutory decision made in response to a motion. Rydell's issue of patentability of the "blade" claims is a separate issue from the Junior Party's issue of patentability of the blade claims. That is, APJ Pate made an interlocutory decision that the "blade" claims were not patentable to Rydell based on recapture. The patentability of the "blade" claims with respect to the Junior Party was never decided because the Junior Party failed to file a motion to establish and decide that issue.

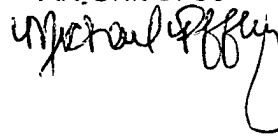
For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

Michael Peffley
Primary Examiner
Art Unit 3739

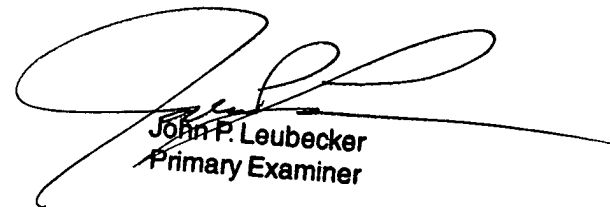


Mp

May 25, 2001

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